

REMARKS

Claims 1-11 and 14-21 are pending. Claims 1, 2, 4, 7, 10, 16, 19, and 20 are amended. Applicants inadvertently numbered the claims and no claims numbered 12 and 13 were in the originally filed application. No new matter is added. In view of the following Remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending rejections for the reasons discussed below.

35 U.S.C. §112 Rejection

Claims 1-21 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In response, Applicants have amended claims 1, 2, 4, 7, 10, 16, 19, and 20 to remove the phrase “and the like”. Applicants submit that the 35 U.S.C. §112 rejection should now be withdrawn.

35 U.S.C. §102(e) and §103 Rejection

Claims 1-21¹ are rejected under 35 U.S.C. §102(e) as being unpatentable over an article entitled “Towards Multidocument Summarization by Reformulation: Progress and Prospects” (“Publication-1”). Claims 1-21 are rejected under 35 U.S.C. §103(a) over a publication by Goldstein entitled “Automatic Text Summarization of Multiple Documents” (“Goldstein”) in view of a publication by Cohen entitled “Fast Effective Rule Induction” (“Cohen”). Applicants submit that the rejections of claims 1-21 are

¹ Claims 12 and 13 were not filed in the original application, and hence, do not exist.

--8--

rendered moot in view of the submitted Declaration under 37 C.F.R. § 1.131, by the named inventors.

Under § 1.131, a rejection under 35 U.S.C. § 102(a) or (e) or § 103 based on a publication may, upon a proper showing, be overcome by removing the publication as a reference against the claims. Applicants submit that the §1.131 Declaration submitted herewith is sufficient to remove the Publication-1 under the §102(e) rejection and the primary reference of Goldstein under the §103(a) rejection as references and thus is sufficient to overcome the above-noted rejections.

More specifically, Applicants submit that the §1.131 Declaration is formally and substantively sufficient to establish that the Inventors had completed the invention defined in at least claims 1, 15, 16 and 21 in the United States before the effective dates of the Publication-1 reference, i.e., July, 1999, and the Goldstein reference, i.e., June 3, 1999. The statements in the Declaration show that the formal requirements of §1.131 are satisfied, namely:

- (1) the rejections to be overcome are under § §102(e) and 103(a),
- (2) all the acts for completing the invention of claims 1, 15, 16, and 21 and those claims dependent thereon were performed in the United States, and
- (3) the effective date of the Publication-1 reference (July, 1999) and the Goldstein reference (June 3, 1999) are not more than one year prior to the effective filing date of the present application.

--9--

It is respectfully submitted that the statements in the Declaration are also sufficient to satisfy the substantive requirements of 37 C.F.R. § 131. The Declaration sets forth specific facts, of sufficient character and weight, to establish a **date of conception** before July, 1999, the effective date of the Publication-1 reference and before June 3, 1999, the effective date of the Goldstein reference and to show that the Inventors and their attorneys exercised **due diligence** from a time before the effective dates of the Publication-1 and Goldstein reference to a constructive reduction to practice, i.e., to the filing date of the application in the United States on July 9, 1999.

DATE OF CONCEPTION

As stated in the Declaration, the Inventors conceived a method and system for providing summaries of documents belonging to a class of documents in a classified document collection before the effective dates of both the Publication-1 and Goldstein references. The method and system include:

- a. inducing a set of rules from a sample set of documents, the set of rules being characteristic of the sample input documents,
- b. extracting the set of rules in order to provide a concise description of the one or more classes of the sample documents;
- c. comparing extracted words, phrases, and terms appearing in the set of rules induced from the sample set of documents to an individual incoming input document, and
- d. providing a summary of the individual incoming input document based on

--10--

matches between the extracted words, phrases, terms and the individual incoming input document.

As further stated in the Declaration, the apparatus and method further include a system and computer program code for:

- a. inducing a set of rules from a sample set of documents, the sample set of documents belonging to at least one class of a classified document collection and the set of rules being characteristic of the sample input documents,
- b. extracting the set of rules in order to provide a concise' description of one or more classes of the sample documents,
- c. comparing the extracted set of rules to at least one individual incoming input document; and
- d. providing a summary of each of the at least one individual incoming input document based on matches between the set of extracted rules and the individual incoming input document.

An IBM Invention Disclosure is submitted with the Declaration as supporting evidence of this prior date of conception. It is respectfully submitted that the Invention Disclosure shows that the Inventors had a definite and permanent idea of the complete and operative invention of all the pending claims 1-21, prior to June 3, 1999, the effective date of the Goldstein reference and also prior to July, 1999, the effective date of Publication-1 reference.

In particular, the Invention Disclosure shows, textually, the features of independent claims 1, 15, 16, and 21 (and dependent claims). Also, Applicants note that

--11--

the original Invention Disclosure shows a date antedating the June 3, 1999 effective date of the Goldstein reference and also the July, 1999 effective date of Publication-1. This and all other pertinent dates have been removed from the photocopies of the Invention Disclosure submitted with the Declaration to prevent any potential prejudice to Applicants.

Applicants further submit that the Declaration filed herewith shows, unequivocally, that the Inventors had in their possession a definite and permanent idea of the complete and operative invention of the pending claims before June 3, 1999 and July 1999 in a manner sufficient to satisfy the requirements of conception, as set forth in M.P.E.P. §§ 715.07 and 2138.04, and thus constitute *prima facie* evidence of Applicants' date of conception of the invention in this country before the effective date of the Goldstein and Publication-1 references, respectively.

DUE DILIGENCE

Applicants further submit that the Declaration shows the Inventors and their attorneys exercised due diligence from a time before the June 3, 1999 effective date of the Goldstein reference and the July, 1999 effective date of the Publication-1 reference to a constructive reduction to practice, realized by the filing of the above-identified parent application on July 9, 1999 in the United States.

The Invention Disclosure documents were forwarded to outside counsel in a timely manner. Discussions between the Inventors and counsel took place until a final application was forwarded to the Inventors for execution, and subsequent filing on July 9, 1999.

Counsel acted in an expeditious manner to prepare the application for filing. Under M.P.E.P. §2138.06, only *reasonable* diligence is required in this regard. More specifically, §2138.06 states that a patent attorney will be held to have exercised reasonable diligence if the attorney worked reasonably hard on the application during the critical period, taking into consideration any backlog of unrelated cases the attorney may have had and his completion of those cases along with the present application in chronological order. Applicants respectfully submit that the Declaration shows that counsel acted sufficiently expeditiously to satisfy the requirements of due diligence.

Applicants submit that the Declaration submitted herewith is sufficient to show that due diligence was exercised as required under 37 C.F.R. § 131. The Inventors remained in regular contact with counsel to answer questions, provide technical explanation, and supply the supplemental disclosure materials necessary for allowing the application to be filed in an expeditious manner.

--13--

CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submit that all of the stated grounds for rejection have been rendered moot. Accordingly, Applicants respectfully submit that all of the claims are allowable and that the application is in condition for allowance. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicants' undersigned representative.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', with a horizontal line extending to the right.

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